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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,017	08/02/2000	Jerry Wynn Brimer	NORTH-358G/A-2185 D1	1088

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STETINA BRUNDA GARRED & BRUCKER  
75 ENTERPRISE, SUITE 250  
ALISO VIEJO, CA 92656

27  
EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/632,017

Applicant(s)

BRIMER ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/03 has been entered.
2. Claims 16-38 are pending in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 16-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Further, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 16 and 20 recite the limitation "having deposited thereon an adhesive mixture of an acid-impervious polymer particulate and a high curing temperature powder adhesive to adhere the particulate to the steel

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surface, the adhesive having a curing temperature lower than a maximum acid-impervious temperature level of the particulate, the adhesive mixture being operative to form an acid-impervious barrier at temperatures above 500°F". Similarly, Claim 26 recites the limitation "a mixture of an acid-impervious polymer particulate and an adhesive, the adhesive having a curing temperature lower than a maximum acid-impervious temperature level of the particulate."

6. However, it is first noted that the original disclosure at the time of filing did not recite that the polymer particulate was acid impervious. The original disclosure at the time of filing stated that the **cured coating** was acid impervious and that the polymer particulate was temperature resistant, not that the polymer particulate was acid impervious. Though the Examiner notes that the Applicant amended the claims and the specification equating the term "acid impervious" to "temperature resistant", it is noted that these two terms are not interchangeable and have different meanings in the art. This is particularly evident by the Applicant's example polymer particulate, polyamide, which can be damaged by acid and hence is not acid impervious. The Applicant specifically refers to KAPTON® by DuPont as the most preferred polyamide, however it is noted that KAPTON® is affected by acid at room temperature and hence is not acid impervious though it is a polyimide with excellent temperature and chemical resistance (*please refer to DuPont Kapton®, page 19.*) Hence, the instant disclosure at the time of filing does not support the limitation "acid-impervious polymer particulate". Additionally, the instant disclosure does not support the limitation "having a curing temperature lower than a maximum acid-impervious temperature level of the particulate" given that the instant disclosure at the time of filing never discloses this limitation.

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7. Further, the instant disclosure does not support the limitations with regards to “500°F” as recited in Claims 16 (above) and Claims 37-38, wherein Claims 37-38 recite that “the adhesive has a curing temperature above about 500°F.” When reviewing the specification, it is noted that the only place in the original disclosure referring to a temperature of 500°F is with regards to the composite material to be cured onto the steel fixture to form a shaped article (*Background, page 1, lines 19-Page 2, line 6*) **not** with regards to the operative or curing temperature of the adhesive as recited in Claims 16, 37 and 38. The original disclosure at the time of filing states that the adhesive is curable at a temperature below about 650°F but does not provide a lower temperature limit other than stating that the powder adhesive in all cases of course cures below the temperature resistant level of the polymer particulate”, Page 3.

8. In addition to these new matter issues, the Examiner notes that the term “acid-impervious” is never defined by the original disclosure and given that the Applicant has provided no guidance in terms of the use of the coated steel substrate which is “substantially acid impervious”, one having ordinary skill in the art would not be able to determine whether the term “acid-impervious” means that the coated substrate can be utilized to hold concentrated hydrochloric acid without being damaged or whether it means the coated substrate is just suitable for outdoor furniture without being damaged by the acid in rain. Considering the multitude of polymeric materials available, having a very wide range of acid resistance, it is unclear how one skilled in the art would be able to select a polymer particulate that is “acid-impervious” without being given any guidance with regards to the meaning of the term. Further, one skilled in the art would not be reasonably apprised of the scope of the claimed invention and could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

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9. Lastly, in further support of the rejection, the Examiner refers the Applicant to previous statements recited in Paper No. 3, paragraphs 3, 5 and 8, in terms of "high curing temperature" and "maximum acid-impervious temperature".

*Response to Arguments*

10. Applicant's arguments filed 7/14/03 have been fully considered but they are not persuasive and/or moot in view of the new ground(s) of rejection. With regards to the term "high curing temperature" and a lower limit of this value, the Applicant once again refers to the Examiner to the paragraph straddling Pages 1-2 of the specification and states that the record as a whole must be considered in making a rejection under 35 U.S.C. 112, 1<sup>st</sup> paragraph. The Examiner believes that the record as a whole has been considered and that, as stated previously and restated above, the recitation at Pages 1-2 refers to the composite part to be produced from the coated substrate, not the curing temperature of the adhesive to be utilized to produce the coated substrate. More specifically, this section teaches that when certain polymer composite materials that cure at elevated temperatures above about 500°F are applied to the steel fixture, these composite materials corrode the steel fixture, hence the instant invention looks to solve the problem by providing a protective cured coating that prevents the steel from corroding when these polymer composite materials that cure above about 500°F are utilized to make a shaped article. Hence, just because the cured coating allegedly prevents corrosion of the steel fixture by polymer composite materials cured at a temperature above about 500°F, does not teach or suggest that the adhesive utilized to form the cured coating is cured at a temperature above about 500°F or that the adhesive is a high temperature curing adhesive. It only suggests that the resulting **cured coating** can be subjected to temperatures above about 500°F while protecting the

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steel from corrosion, wherein it is noted that the uncured adhesive and the cured adhesive typically have different characteristics as a result of the curing process. Therefore, though the present invention is linked to the problem to be solved, this background recitation does not provide support for the limitations as recited in the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson  
Patent Examiner  
Technology Center 1700  
August 21, 2003